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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAEL R. JOSEPH, KEISHA CLARKE, DUANE G. KRZYSIK
and BERNARD J. MINERATH, III

Appeal 2008-4078
Application 10/660,203
Technology Center 1600

Decided:¹ March 10, 2009

Before ERIC GRIMES, RICHARD M. LEOVITZ, and
MELANIE L. MCCOLLUM, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery)

This is a decision on appeal from the Examiner's final rejection of claims 1-10, 12-41, and 43-59. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The claims are directed to a moisturizing and lubricating composition comprising an emollient, a humectant, an immobilizing agent, and a compatibilizing agent in specifically recited amounts. According to the Specification, the composition provides "a reduction in the frictional discomfort and dryness associated with the use of absorbent articles and tissue products" (Spec. ¶ 10).

Claims 1-10, 12-41, and 43-59 are pending and appealed; claims 11 and 42 are pending, but withdrawn from consideration. The claims stand finally rejected by the Examiner as follows:

1) Claims 1-4, 8-10, 12, 13, 15, 16, 25-31, 34, 35, 39-41, 43-45, 52-54, and 57-59 under 35 U.S.C. § 102(b) as anticipated by Krzysik '075 (US 5,869,075, Feb. 9, 1999) (Ans. 3);

2) Claims 1-4, 8-10, 12, 13, 15-17, 21, 22, 25-31, 34, 35, 39-41, 43-46, 50-54, and 57-59 under 35 U.S.C. § 102(b) as anticipated by Tyrell (US 2002/0120241 A1, Aug. 29, 2002) (Ans. 5);

3) Claims 1-10, 12, 13, 15-22, 25-31, 34-41, 43-54, and 57-59 under 35 U.S.C. § 102(b) as anticipated by Krzysik '409 (WO 00/64409, Nov. 2, 2000) (Ans. 6);

4) Claim 32 under 35 U.S.C. § 103(a) as obvious in view of Krzysik '409 (Ans. 8);

5) Claims 23, 24, 55, and 56 under 35 U.S.C. § 103(a) as obvious in view of Krzysik '409 and Elias (US 5,643,899, Jul. 1, 1997) (Ans. 6);

6) Claims 14 and 33 under 35 U.S.C. § 103(a) as obvious in view of Krzysik '409 and Mitchnick (US 6,103,267, Aug. 15, 2000) (Ans. 10);

7) Claims 1-10, 12-41, and 43-59² on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1-30 and 32-60 of co-pending Application Serial No. 10/659,969 and claims 1-59 of co-pending Application Serial No. 10/659,862 (Ans. 12);

8) Claims 1-10, 12-13, 25-32, 34-41, 43, and 52-59 on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 16-33 of Krzysik '075 (Ans. 15); and

9) Claims 1, 4-10, 13, 15-17, 21, 22, and 25-30 on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1-43 of Krzysik '197 (US 6,475,197 B1, Nov. 5, 2002) (Ans. 17).

We select claim 1 as representative of the claimed subject matter.
Claim 1 reads as follows:

1. A moisturizing and lubricating composition comprising
from about 1% (by weight) to about 40% (by weight) of
an emollient,
from about 1% (by weight) to about 20% (by weight) of a
humectant,
from about 30% (by weight) to about 90% (by weight) of
an immobilizing agent, and
from about 1% (by weight) to about 40% (by weight) of a
compatibilizing agent,
wherein no more than about 50% (by weight) of the
components are liquid at room temperature and no less than
about 50% of the components are solid at room temperature,
and

² The Examiner also included claims 11 and 42 in this rejection. However, claims 11 and 42 have been withdrawn from consideration (Office Action mailed April 18, 2007, at 2).

wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C.

ANTICIPATION REJECTIONS

ISSUE

The threshold issue in the anticipation rejections involves the proper interpretation of claim 1. We frame this issue as follows:

Does the claimed range of “a humectant” of “from about 1% (by weight) to about 20% (by weight)” limit the total amount of humectant in the composition to this range, or just require the presence of at least one humectant within the claimed range?

Once the claim has been properly interpreted, we must determine:

Do the cited prior art references describe a composition which comprises emollient, humectant, immobilizing agent, and compatibilizing agent in the claimed amounts?

PRINCIPLES OF LAW

“A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps. First, the Board must interpret the claim language . . . Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that ‘each and every limitation is found either expressly or inherently in [that] single prior art reference.’ *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).” *In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

During examination proceedings, claim terms are given “the broadest reasonable meaning . . . in their ordinary usage as they would be understood

by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the Patent and Trademark Office can require [an] applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”). *See also In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

CLAIM INTERPRETATION

We begin with claim interpretation because before a claim is properly interpreted its scope cannot be compared to the prior art. *See In re Crish*, 393 F.3d at 1256.

Claim 1 is directed to a moisturizing and lubricating “comprising” four components:

- 1) emollient: from about 1% to about 40% by weight;
- 2) humectant: from about 1% to about 20% by weight;
- 3) immobilizing agent: from about 30% to about 90% by weight; and

4) compatibilizing agent: from about 1% to about 40% by weight.

The composition is required by the claim to have the following two additional characteristics:

- “no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature”, and
- “at least about 85% (by weight) of the components form a single phase at a temperature of from about 45°C to about 80°C”.

Appellants contend that the limitation in claim 1 that “a humectant” be present in a range “from about 1% (by weight) to about 20%” means that “the total amount of components . . . that act as humectants” in the composition must be within the claimed range (App. Br. 8-9). The Examiner contends that the claim limitation “comprising” is open-ended and does not exclude additional elements from being present in the claimed composition, including additional humectants (Ans. 24). Thus, the proper interpretation of this limitation is in dispute in this appeal.

Claim 1 recites that the composition comprises “from about 1% (by weight) to about 20% (by weight) of a humectant.” The term “a” is an indefinite article which is customary interpreted to mean “at least one”, permitting the inclusion of additional elements which are not recited in the claim. *KCJ Corp. v. Kinetic Concepts Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000). Based on this interpretation, the Examiner concluded that although a range of 1-20% was recited, because the claim referred to “a humectant”, its scope could include additional humectants – opening the claim to a range outside the stated limit of “about 20%.” While claims are given their broadest reasonable interpretation during patent prosecution, we must “tak[e] into account whatever enlightenment by way of definitions or

otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d at 1054. Therefore, we turn to the Specification for additional guidance.

In the "Summary of the Invention," the Specification states that the "present invention is generally directed to moisturizing and lubricating compositions for use in combination with absorbent products such as disposable diapers" (Spec. ¶ 7). The composition is stated to have an emollient, humectant, immobilizing agent, and compatibilizing agent in the same ranges which are recited in claim 1 (Spec. ¶ 10).

In describing the humectant, the Specification states:

The humectant component of the moisturizing and lubricating compositions of the present invention are generally present in an amount of from about 1% (by weight) to about 20% (by weight), preferably from about 5% (by weight) to about 15% (by weight).

(Spec. ¶ 61.) Thus, although claim 1 recites that the composition comprises "a humectant", when describing the same range of humectant which is claimed, the Specification refers to it as "[t]he humectant component", i.e., with the definite article "the" to denote that the 1-20% represents the total amount of humectant in the composition.

Consistently, the description in the Specification of immobilizing agent also utilizes the phrase "[t]he immobilizing agent" in its statement of the amount of immobilizing agent present in the moisturizing and lubricating composition (*id.* ¶ 62). The range of "[t]he immobilizing agent" is broadly stated to be from about 30-90% by weight, the same range which is also recited in claim 1.

In its description of emollient, the Specification states:

The moisturizing and lubricating compositions of the present invention comprise from about 1% (by weight) to about 40% (by weight) of an emollient. As used herein, the term “by weight” refers to the total weight of the moisturizing and lubricating composition. Thus, if a moisturizing and lubricating composition is 25% (by weight) emollients and has a total weight of 100 grams, the composition[] comprises 25 grams of emollient.

(Spec. ¶ 50.) In this case, although the Specification refers to “an emollient” with the indefinite article “an”, it describes how to calculate the “total weight” of “emollients” present in the composition to be within the claimed range of about 1% to 40%.

Thus, when the claims are read in the context of the Specification of which they are part, it is apparent that the term “a” or “an” as used in claim 1 refers to the total weight amount of the stated agent in the composition.

In sum, we interpret the phrase “from about 1% (by weight) to about 20% (by weight) of a humectant” to mean the total amount of humectant that is in the claimed moisturizing and lubricating composition.

1. ANTICIPATION BY KRZYSIK ‘075

Claims 1-4, 8-10, 12, 13, 15, 16, 25-31, 34, 35, 39-41, 43-45, 52-54, and 57-59 stand rejected under 35 U.S.C. § 102(b) as anticipated by Krzysik ‘075 (Ans. 3).

Findings of Fact

1. The Examiner finds that Examples 7 (Krzysik ‘075, at col. 7, ll. 19-42), 11 (*id.* at col. 8, ll. 10-22), and 12 (*id.*) anticipate claim 1 (Ans. 4).
2. We summarize these findings as follows:

| Claim | Example 7 | Example 11 | Example 12 |
|-----------------------------|--|--|---|
| 1-40% emollient | 10% dimethicone copolyol | 10% dimethicone | 10% dimethicone |
| 1-20% humectant | 20% starch hydrolysate; 10% propylene glycol =30% | 10% hispagel; 35% propylene glycol =45% | 15% starch hydrolysate; 28% propylene glycol =43% |
| 30-90% immobilizing agent | 20% PEG ³ -1000; 30% PEG-8000 =50% | 20% PEG-8000; 10% stearyl alcohol; 10% behenyl alcohol =40% | 15% PEG-8000 10% stearyl alcohol; 10% behenyl alcohol =35% |
| 1-40% compatibilizing agent | 10% propylene glycol ; 10% PEG-400 =20% | 35% propylene glycol | 28% propylene glycol |

3. Appellants do not dispute the Examiner's findings as to the components in Examples 7, 11, and 12 and how they correspond to the emollient, humectant, immobilizing agent, and compatibilizing agent of claim 1.

4. Propylene glycol is characterized in the Specification as a humectant (Spec ¶ 61, l. 22) and compatibilizing agent (Spec. ¶ 66, l. 13).

5. When propylene glycol is counted as both a compatibilizing agent and humectant, the total amount of humectant in each of Examples 7, 11, and 12 exceeds the claimed upper limit of about 20%, i.e., 30%, 45%, and 43%, respectively (FF2).

³ Polyethylene glycol is abbreviated "PEG."

Analysis

The question in this rejection is whether Krzysik '075 describes a composition that meets the limitations of the claimed moisturizing and lubricating composition of claim 1. Appellants contend that the humectant element is not met because each of Examples 7, 11, and 12 of Krzysik '075 describes compositions with a total amount of humectant which exceeds the claimed limitation of about 20% (App. Br. 9-10). The Examiner contends that the claim language “a humectant” does not exclude the addition of other humectants outside the claimed range (Ans. 24). Thus, as long as there is at least one humectant within the claimed range – as there is in Examples 7, 11, and 12 – the claim is anticipated (*id.*).

We have interpreted the limitation that the composition comprises “from about 1% (by weight) to about 20% (by weight) of a humectant” to limit the total amount of humectant which is present in the composition. As Examples 7, 11, and 12 disclose compositions with 30%, 45%, and 43% of humectant, respectively (FF2), we conclude that the claimed limitation of about 20% humectant is not met by Krzysik. For this reason, we reverse the rejection of claims 1-4, 8-10, 12, 13, 15, 16, 25-31, 34, 35, 39-41, 43-45, 52-54, and 57-59 as anticipated by Krzysik '075.

2. ANTICIPATION BY TYRELL

Claims 1-4, 8-10, 12, 13, 15-17, 21, 22, 25-31, 34, 35, 39-41, 43-46, 50-54, and 57-59 stand rejected under 35 U.S.C. § 102(b) as anticipated by Tyrell (Ans. 5).

Findings of Fact

6. The Examiner finds that Examples 13 (Tyrell, at 24, col. 1, Table 1) and 20 (*id.*) anticipate the composition of claim 1 (Ans. 5-6).

7. We summarize these findings as follows:

| | Example 13 | Example 20 |
|-----------------------------|---|--|
| 1-40% emollient | 10% dimethicone | 20% dimethicone treated zinc oxide |
| 1-20% humectant | 5% starch hydrolysate; 28% propylene glycol =33% | 10% propylene glycol |
| 30-90% immobilizing agent | 25% PEG 10,000 25% behenyl alcohol =50% | 15% PEG 10,000; 10% stearyl alcohol =25% |
| 1-40% compatibilizing agent | 28% propylene glycol | 4% PEG 200 10% propylene glycol =14% |

8. Appellants do not dispute the Examiner's findings as to the components in Example 13 and how they correspond to the emollient, humectant, immobilizing agent, and compatibilizing agent of claim 1.

9. When propylene glycol is counted as both a compatibilizing agent and humectant, the total amount of humectant in Example 13 (i.e., 33%) exceeds the claimed upper limit of 20% (FF7).

10. Appellants do not dispute the Examiner's findings as to the components in Example 20 and how they correspond to the humectant, immobilizing agent, and compatibilizing agent of claim 1.

11. Tyrell teaches that dimethicone is an emollient and can be incorporated in the form of a dimethicone treated powder such as dimethicone-treated zinc oxide (Tyrell, at ¶ 32).

12. The amount of immobilizing agent in Tyrell's Example 20 is 25% by weight of the composition.

Analysis

The question in this rejection is whether Tyrell describes a composition which meets the limitations of the composition of claim 1. The Examiner has cited two examples in Tyrell which she finds anticipates the claimed subject matter. We address them separately.

As to Example 13, Appellants argue, as they did for Krzysik '075, that the amount of humectant exceeds the claimed upper limit (*see* FF 8, 9; App. Br. 19). For the same reasons discussed above, we agree with Appellants that the claimed limitation drawn to a range of a humectant refers to the total humectant amount present in the composition. As this range is exceeded (FF7), we agree with Appellants that Example 13 does not anticipate the composition of claim 1.

As to Example 20, Appellants argue: 1) that dimethicone treated zinc oxide is not an emollient; and 2) there is insufficient immobilizing agent in the composition (App. Br. 4).

Tyrell clearly teaches that dimethicone treated zinc oxide is an emollient (FF11). Consequently, we are not convinced that the emollient limitation is not met by Tyrell's composition.

With regard to Appellants' argument that there is insufficient immobilizing agent in the composition, we acknowledge that Tyrell's composition comprises 25% by weight of the composition (FF12) which is less than "30%" as recited in claim 1. However, claim 1 requires "about 30%." The Examiner does not explain how "about 30%" is met by 25%. It is the Examiner's burden to establish *prima facie* anticipation. As the

Examiner has not addressed Appellants' argument nor provided a rationale for reading 25% to be "about 30%", we are compelled to reverse the rejection of claims 1-4, 8-10, 12, 13, 15-17, 21, 22, 25-31, 34, 35, 39-41, 43-46, 50-54, and 57-59 as anticipated by Tyrell.

3. ANTICIPATION BY KRZYSIK '409

Claims 1-10, 12, 13, 15-22, 25-31, 34-41, 43-54, and 57-59 stand rejected under 35 U.S.C. § 102(b) as anticipated by Krzysik '409 (Ans. 6).

Findings of Fact

13. The Examiner finds that the example on page 9, lines 293-297, of Krzysik '409 anticipates claim 1 (Ans. 8: 4-10; 36-38).

The following findings of fact are relevant to the state of the components in Krzysik '409 example (and also the factual basis for FF23):

14. Glycerin is a liquid at room temperature (Ans. 37).

15. Evening primrose is a liquid at room temperature (Ans. 37).

16. The example refers to "polyethylene 200" (Krzysik '409, at 9: 294), but it is obvious that this is an error and that "polyethylene glycol 200" was intended because the latter compound is recited in another example (*id.* at 9: 287) and is described generically (*id.* at 5: 150, referring to "low molecular weight polyethylene glycol").

17. Polyethylene glycol 200 (PEG-200) is liquid at room temperature (Appeal Br., Exhibit E; "Melting point increases as molecular weight increases"; the melting point of PEG-400 is from 4-8°C; therefore, PEG-200 with a lower molecular weight would have lower melting point which would be less than room temperature).

18. Glycol stearate is a solid at room temperature (Ans. 38).
19. Soy sterol is a solid at room temperature (Ans. 38).
20. PEG-8000 is solid at room temperature and until it reaches 61°C, its melting point (MP) (Appeal Br., Exhibit B).
21. Behenyl alcohol is solid at room temperature and until it reaches 65-73°C, its melting point (Appeal Br., Exhibit C).
22. Stearyl alcohol is solid at room temperature and until it reaches 61°C, its melting point (Appeal Br., Exhibit D).
23. To summarize:

| Claim | Page 9, lines 293-297 |
|---|---|
| 1-40% emollient | 5% evening primrose; 10% behenyl alcohol (MP=65-73°C); 10% stearyl alcohol (MP=61°C) =25% |
| 1-20% humectant | 5% glycerin |
| 30-90% immobilizing agent | 20% PEG-8000 (MP=61°C); 10% behenyl alcohol (MP=65-73°C); 10% stearyl alcohol (MP=61°C) =40% |
| 1-40% compatibilizing agent | 42% polyethylene glycol 200 |
| At least about 85% by weight in a single phase from about 45°C to 85°C | Liquid at above 73°C: 1) 5% evening primrose; 2) 5% glycerin; 3) 20% PEG-8000 (MP=61°C); 4) 10% behenyl alcohol (MP=65-73°C); 5) 10% stearyl alcohol (MP=61°C); 6) 42% polyethylene glycol 200 =92% at single-phase at above 73°C |
| - No less than 50% solid at room temperature - No more than 50% liquid at room | Liquid at room temperature 1) 5% evening primrose 2) 5% glycerin |

| | |
|-------------|---|
| temperature | 3) 42% polyethylene glycol 200 = 52% liquid Solid at room temperature 1) 20% PEG-8000; 2) 10% behenyl alcohol; 3) 10% stearyl alcohol; 4) 5% glycol stearate 5) 3% soy sterol = 48% solid at room temperature |
|-------------|---|

Analysis

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d at 631. In this case, we agree with the Examiner’s findings as summarized in FF14 above that Krzysik ‘409 describes a composition that anticipates all the limitations of claim 1. The composition comprises 25% emollient, 5% humectant, 40% immobilizing agent, and 42% compatibilizing agent – each of which are within or at “about” the claimed limitations (FF14).

Krzysik ‘409 does not state that “at least about 85%” of its components “form a single phase at a temperature of about 45°C to 85°C” as claimed, but based on the evidence of record, we conclude that the Examiner had reasonable basis for concluding that such limitation is met (FF14-23 at col. 2, row 6). Likewise, it is not stated in Krzysik ‘409 that no less than 50% of the components are solid at room temperature and no more than 50% are liquid at room temperature as required by claim 1. However, the Examiner had reason to believe that such limitation is satisfied by Krzysik ‘409 (FF14, at col. 2, row 7). *See* FF14-23.

Once a *prima facie* case of anticipation has been established, the burden shifts to the Appellants to prove that the prior art product does not possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255. Appellants address the general teachings of Krzysik ‘409, and several of its examples (App. Br. 22-26), but not the example on page 9, lines 293-297 which was clearly relied upon by the Examiner in the rejection (Ans. 8: 4-10;⁴ 36-38). For instance, based on her calculations as summarized in FF14, the Examiner concluded that the prior art teaching of 52% liquid “reads on the instant ‘about 50%’” and that the teaching of 48% solid “reads on the instant ‘about 50%’” limitation (Ans. 38). Appellants did not challenge these specific findings.⁵

Appellants did not separately argue the patentability of claim 31, but instead stated that the “[c]laim is similar to claim 1 and is patentable over the Krzysik, et al. reference for the same reasons as claim 1 set forth above as well as for the additional elements it requires” (App. Br. 27). “A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

For the foregoing reasons, we affirm the rejection of claim 1. Claims 2-10, 12, 13, 15-22, 25-31, 34-41, 43-54, and 57-59 fall with claim 1

⁴ The Examiner did not refer to the line numbers, but the example described by the Examiner is the same as the example listed at lines 293-297 on page 9 of Krzysik ‘409.

⁵ Arguments not made are waived. See 37 C.F.R. § 41.37(c)(1)(vii) (“Any arguments or authorities not included in the brief or a reply brief ... will be refused consideration by the Board, unless good cause is shown.”).

because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

OBVIOUSNESS REJECTIONS

4. OBVIOUSNESS OVER KRZYSIK ‘409

Claim 32 stands rejected under 35 U.S.C. § 103(a) as obvious over Krzysik ‘409 (Ans. 8).

The Examiner states that “Krzysik does not specifically teach the instantly claimed 1 to 1 ratio of silicone to dispersing agent” (Ans. 9).

However, the Examiner concludes that it

would have been obvious to one of ordinary skill in the art at the time the invention was made to manipulate the ratio of silicone to dispersing agent in view of the guidance provided by Krzysik et al. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical.

(*Id.*)

Appellants generally argue the non-obviousness of claim 31 (App. Br. 29). However, this claim was rejected as anticipated by Krzysik ‘409 (Ans. 6), not as obvious over it.

In regard to claim 32 which is the subject of this rejection, Appellants do not identify a defect in the Examiner’s reasoning. As we agree with the Examiner’s position, and Appellants have not provided rebuttal arguments or evidence, we affirm the rejection.

5. OBVIOUSNESS OVER KRZYSIK '409 AND ELIAS

Claims 23, 24, 55, and 56 stand rejected under 35 U.S.C. § 103(a) as obvious over Krzysik '409 and Elias (Ans. 6).

Because Appellants did not separately argue the claims, we select claim 24 as representative. Claim 24 is directed a composition of claim 1, further comprising a ceramide which is a glucosylceramide.

The Examiner states that Krzysik '409 does not teach glucosylceramide in its composition as required by claim 24, but finds that Elias teaches its benefits for skin (Ans. 9-10). The Examiner concludes persons of ordinary skill in the art would have had reason "to add glucosylceramide [to Krzysik's composition] with the expectation of success since Elias teaches the use of natural lipid species treats and prevents damage to the skin and mucous membrane and Krzysik teaches the additional use of active agents such as natural moisturizing agents and skin protectants that protect the ski[n] and mucous membrane" (Ans. 10).

Appellants do not provide arguments as to why the combination of Krzysik '409 and Elias is improper. As the Examiner has provided a logical reason for combining the cited prior art, and Appellants have not identified any infirmity in it, we affirm the rejection of claim 24. Claims 23, 55, and 56 were not separately argued and fall with claim 24. 37 C.F.R. § 41.37(c)(1)(vii).

6. OBVIOUSNESS OVER KRZYSIK '409 AND MITCHNICK

Claims 14 and 33 stand rejected under 35 U.S.C. § 103(a) as obvious over Krzysik '409 and Mitchnick (Ans. 10).

Because Appellants did not separately argue the claims, we select claim 14 as representative. Claim 14 is directed a composition of claim 1, further comprising a dispersing agent which is selected from a list that includes modified polydimethylsiloxanes.

The Examiner states that Krzysik '409 does not describe the modified polydimethylsiloxanes recited in claim 14, but it does teach the use of dispersing agents ("surfactants") in its compositions (Ans. 10). The Examiner finds that Mitchnick describes modified polydimethylsiloxanes as in claim 14 and their functional equivalency to other surfactants (*id.* at 11). The Examiner concludes that persons of ordinary skill in the art "would have been motivated to utilize any known surfactant known to those skilled in the art [in Krzysik's compositions] because Mitchnick teaches [their] functional equivalency" (*id.* at 11-12).

Appellants do not provide arguments as to why the combination of Krzysik '409 and Elias is improper. As the Examiner has provided a logical reason for combining the cited prior art, and Appellants have not identified any infirmity in it, we affirm the rejection of claim 14. Claim 33 falls with claim 14 because separate arguments for its patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

DOUBLE-PATENTING REJECTIONS

7. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE-PATENTING REJECTION

Claims 1-10, 12-41, and 43-59 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1-30 and 32-60 of co-pending Application Serial No.

10/659,969 and claims 1-59 of co-pending Application Serial No.
10/659,862 (Ans. 12).

As Appellants have not addressed the merits of the rejection, but rather state they “would like to delay responding to this rejection” (App. Br. 35), we summarily affirm it.

8. OBVIOUSNESS-TYPE DOUBLE PATENTING OVER KRZYSIK ‘075

Claims 1-10, 12-13, 25-32, 34-41, 43, and 52-59 stand rejected on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 16-33 of Krzysik ‘075 (Ans. 15).

Issue

Is the composition of instant claim 1 an obvious variant of the patented composition of Krzysik ‘075?

Findings of Fact

24. The Examiner finds that claim 1 is not patentably distinct from claims 16-33 of Krzysik ‘075 (Ans. 15). In support of this, the Examiner refers to Krzysik ‘075’s claims 16, 17, 23, 29, and 30.

25. We summarize these findings as follows (‘075 claims 17, 23, 29, and 30 depend on claim 16):

| Claim 1 | '075 Claim 16 | '075 Claim 17 | '075 Claim 23 | '075 Claim 29 ⁶ | '075 Claim 30 ⁷ |
|-------------------------------------|---|---|--|--|---|
| 1-40% emollient | 5-40% C14- C30 fatty alcohol (See instant Spec. ¶ 53) | | 10% cetyl alcohol | 10% behenyl alcohol; 10% stearyl alcohol | 10% behenyl alcohol; 10% stearyl alcohol |
| 1-20% humectant | 30-90% <i>hydrophilic solvent</i> | <i>hydrophilic solvent is propylene glycol; glycerin; or starch hydrolysate</i> | 25% starch hydrolysate; 15% <i>propylene glycol</i> =40% | 35% <i>propylene glycol</i> | 30% <i>propylene glycol</i> ; 15% starch hydrolysate =45% |
| 30-90% immobilizing agent | 10-50% high molecular weight PEG; 5-40% C14- C30 fatty alcohol (See instant Spec. ¶ 63) | | 50% high molecular weight PEG; 10% cetyl alcohol | 20% high molecular weight PEG; 10% behenyl alcohol; 10% stearyl alcohol | 15% high molecular weight PEG; |
| 1-40% compatibiliz- ing agent | 30-90% <i>hydrophilic solvent</i> | <i>hydrophilic solvent is propylene glycol; or low molecular weight PEG</i> | 15% <i>propylene glycol</i> | 35% <i>propylene glycol</i> | |
| At least about 85% | Melting point between | | | | |

⁶ Not all the components recited in the claim are listed in the table.

⁷ Not all the components recited in the claim are listed in the table.

| | | | | | |
|---|-----------|--|--|--|--|
| by weight in a single phase from about 45°C to 85°C | 30°C-70°C | | | | |
|---|-----------|--|--|--|--|

26. As shown in FF25, there is no overlap between the subject matter in Kryzsik '075's claims 17, 23, 29, and 30 and the composition of instant claim 1. The amount of humectant in each claim exceeds the instantly claimed range of from about 1% to about 20%. (*See also* App. Br. 36-38.)

27. The composition in Kryzsik '075's claim 16 meets the emollient and immobilizing agent limitations of instant claim 1 (FF25).

28. However, the 30-90% hydrophilic solvent can be either a humectant or compatibilizing agent, or both, and thus does not necessarily overlap or meet the corresponding limitations of claim 1.

Analysis

“Obviousness-type double patenting . . . requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent. Its purpose is to prevent an unjustified extension of the term of the right to exclude granted by a patent by allowing a second patent claiming an obvious variant of the same invention to issue to the same owner later.” *In re Berg*, 140 F.3d 1428, 1431 (Fed. Cir. 1998).

In this case, the Examiner acknowledges differences between Kryzsik '075's claim 16 and instant claim 1, but contends that the patented “dependent claims claim the instant combination” (Ans. 17). However, no evidence has been presented to substantiate this assertion. On page 16 of the

Answer, the Examiner identifies the components recited in patented dependent claims 17, 23, 29, and 30. However, as shown in Findings of Fact 25-28, there does not appear to be overlap between the subject matter of Kryzysik '075 claims 17, 23, 29, and 30 and instant claim 1. The Examiner has not provided any rationale as to why persons of ordinary skill in the art would have considered compositions having components in the ranges instantly claimed to be obvious variants of the compositions claimed in Kryzysik '075.

As for claim 16, the Examiner has not explained how the hydrophilic solvent, which can be both a humectant and immobilizing agent, would fulfill the humectant function required by instant claim 1. While it might be possible to utilize a quantity of a hydrophilic solvent that would meet the humectant limitation of claim 1, and not exceed it, the Examiner has not provided a reason as to why a composition having the claimed 1-20% humectant would have been an obvious variant of the composition having a total of 30-90% hydrophilic solvent, as claimed in the '075 claim 16. Accordingly, we are compelled to reverse this rejection.

9. OBVIOUSNESS-TYPE DOUBLE PATENTING OVER KRZYSIK '197

Claims 1, 4-10, 13, 15-17, 21, 22, and 25-30 stand rejected on the ground of non-statutory obviousness-type double patenting as unpatentable over claims 1-43 of Krzysik '197 (Ans. 15).

Issue

Would persons of ordinary skill in the art have considered the patented compositions in Krzysik '197 to be obvious variants of a

composition “wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature” as required by instant claim 1?

Principles of Law

Where a claimed range overlaps with a range disclosed in the prior art, there is a presumption of obviousness. *See Iron Grip*, 392 F.3d at 1322; *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997). The presumption can be rebutted if it can be shown that the prior art teaches away from the claimed range, or the claimed range produces new and unexpected results. *Iron Grip*, 392 F.3d at 1322; *In re Geisler*, 116 F.3d at 1469; *Haynes Int’l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1577 n.3 (Fed. Cir. 1993) (“[W]hen the difference between the claimed invention and the prior art is the range or value of a particular variable, then a prima facie rejection is properly established when the difference in range or value is minor.”) (emphasis omitted); *In re Malagari*, 499 F.2d 1297, 1303 (CCPA 1974) (claimed invention is rendered prima facie obvious by the teachings of a prior art reference that discloses a range that touches the range recited in the claim).

Ormco Corp. v. Align Technology Inc., 463 F.3d 1299, 1311 (Fed. Cir. 2006).

Findings of Fact

29. We summarize the correspondence between the instant claims and the patented claims of Krzysik ‘197 as follows (‘197 claims 2, 8, and 9 depend on claim ‘197 claim 1):

| Claim 1 | '197 Claim 1 | '197 Claim 2 | '197 Claim 8 | '197 Claim 9 |
|--|--|--|--|--|
| 1-40% emollient | 1-30% C14-C30 fatty alcohol; 0.1-30% natural fats, oils | | | |
| 1-20% humectant | 0.5%-10% humectant | | hydrophilic solvent is propylene glycol | |
| 30-90% immobilizing agent | 5-95% high molecular weight PEG; 1-30% C14-C30 fatty alcohol | | | |
| 1-40% compatibilizi ng agent | <i>10-90% hydrophilic solvent</i> | | hydrophilic solvent is propylene glycol | hydrophilic solvent is low molecular weight PEG |
| At least about 85% by weight in a single phase from about 45°C to 85°C | | Melting point from 30°C to 100°C | | |

30. As summarized in FF29, the amounts of components recited in instant claim 1 either encompass or overlap those in claims 1, 2, 8, and 9 of the Krzysik '197 patent; there is also overlap in the range that the claimed and patented compositions would be in a single phase (i.e., melting point from 30°C to 100°C as recited in claim 2 of the Krzysik '197 patent).

31. It is not stated in Krzysik '197 that no less than 50% of the components are solid at room temperature and no more than 50% are liquid at room temperature as required by claim 1. However, the Examiner finds:

[it] is within the skill of an artisan to manipulate the amount to yield the instant claimed composition wherein no more than about 50% of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature. For instance, US '197 claims 5% as the lower limit of the hydrophilic solvent which is liquid at room temperature; 95% as the maximum limit of the high molecular weight PEG which is solid at room temperature (note applicant claims "about 90%" and applicant has not defined "about" to mean exactly in the specification . . .); 10% as the maximum weight of the humectant, which is liquid at room temperature; and 1% as the lower limit of the fatty alcohols, which are solid at room temperatures. Clearly the maximum and minimum ranges claimed in US '197 yield a composition wherein no more than about 50% of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature.

(Ans. 53-54).

Analysis

The issue in this rejection is whether the patented claims of Krzysik '197 define compositions that are obvious variants of the composition of claim 1, including the limitation that "no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature."

The Examiner contends is that it would have been routine to have manipulated the amounts of the components in the patented claims to have made a composition with the claimed amount of solid and liquid (see FF31). Appellants contend

Nothing in claims 1-43 of '197 state that their absorbent products should comprise a composition having no more than about 50% (by weight) of components that are liquid at room temperature and no less than about 50% of components that are solid at room temperature. More importantly, there is no recognition in the claims of '197 or otherwise of the advantages of using such a composition, and nothing to suggest that the compositions used in the absorbent products of '197 would inherently have such a makeup.

(App. Br. 40-41). Appellants also point out that the ranges of the humectant (when the hydrophilic solvent is included) can exceed those required by instant claim 1 (*id.*).

Appellants have the better argument. An overlap in ranges is sufficient to create a presumption of obviousness. However, in this case, while there is overlap in the emollient, humectant, immobilizing agent, and compatibilizing agent between the instant and claimed compositions, there is no explicit teaching in the patented claims that the constituents should be selected such that no more than 50% is liquid and no less than 50% is solid. The Examiner's explanation as summarized in FF31 does not provide a reason as to why persons of ordinary skill in the art would considered a composition with the claimed amounts of liquid and solid components to be an obvious species or subgenus within the scope of the claims of Krzysik '197. Accordingly, we are compelled to reverse the rejection.

CONCLUSION OF LAW

1-2. We reverse the anticipation rejections over Krzysik '075 and Tyrell because the Examiner has not established under the proper interpretation of claim 1 that these references describe a composition which meets all the limitations of claim 1.

3. Because the properly interpreted claim 1 reads on a composition disclosed in Krzysik '409, we affirm the anticipation rejection of claim 1-10, 12, 13, 15-22, 25-31, 34-41, 43-54, and 57-59 over it.

4-6. As Appellants did not identify a defect in the Examiner's reason for modifying Krzysik '409 alone or to have combined Krzysik '409 with Elias or Mitchnik, we affirm the obviousness rejections of claims 14, 23, 24, 32, 33, 55, and 56.

7. Because Appellants did not address the merits of the rejections, we affirm the provisional obviousness-type double patenting of claims 1-10, 12-41, and 43-59 over claims 1-30 and 32-60 of co-pending Application Serial No. 10/659,969 and claims 1-59 of co-pending Application Serial No. 10/659,862.

8. We reverse the obviousness-type double-patenting rejection over Krzysik '075 because the Examiner has not established that persons of ordinary skill in the art would have considered the patented composition to be an obvious variant of instant claim 1.

9. The Examiner has not established that persons of ordinary skill in the art would have considered the patented compositions in Krzysik '197 to be obvious variants of a composition "wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature" as required by instant claim 1. Accordingly, we reverse the obviousness-type double-patenting rejection based on Krzysik '197.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

lp

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